UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,384	07/06/2001	Shekhar Kirani	LS/0010.00	7192

8791	7590	04/06/2006

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER
BENGZON, GREG C

ART UNIT	PAPER NUMBER
2144	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/900,384 | Applicant(s) KIRANI ET AL. |
| | Examiner Greg Bengzon | Art Unit 2144 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33 and 46-51* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33 and 46-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

This application has been examined. Claims 1-33, 46-51 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/13/2006 has been entered.

Priority

The claimed inventions have been verified with the parent applications 09/588875 filed 6/6/2000 and 60/203407 filed 06/11/2000. The parent applications do not support the claims' subject matter. Hence, they do not entitle this application to a benefit of earliest filling date.

The effective date of the claims described in this application is July 6, 2001.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-33 and 46-51 are rejected under 35 U.S.C, 103(a) as being

unpatentable over Rabe-Hesketh et al. (WO 00/72534 A1) and Gabrielsson et al. (WO

01/01663 AI).

Regarding claims 1, 4-6, 18, 46 and 51 Rabe-Hesketh discloses a method,

apparatus and computer program (collectively referred to as "system") for automatically

processing messages containing attachments, the method comprising: receiving a

particular message having a particular attachment; removing the particular attachment

from the particular message based on predefined criteria e.g., size of the attachment;

inserting a link into the particular message, said link capable of referencing the

particular attachment that has been removed; in response to invocation of the link by

the intended recipient, retrieving a copy of the particular attachment that is automatically

formatted based on the specified preference (Rabe-Hesketh - Abstract, Page 3, Lines

25-37; Page 3, Line 24-Page 4, Line 25; Page 5, Line 25-Page 6,Line 25; Page 7, Line

20-Page 11, Line 37).

Rabe-Hesketh does not explicitly disclose specifying a preference for formatting

attachments and does not explicitly apply predefined criteria in response to a client's

capability, e.g., exceeding client capability. Rabe-Hesketh does not disclose _detecting_
an intended recipient's receiving device during a request from the recipient to retrieve
the particular message and thus formatting attachments accordingly.

However, in the same field of endeavor, a teaching that has objective akin to
Rabe-Hesketh, Gabrielsson teaches a system for communicated media object to an e-
mail recipient, which is capable of modifying object format based on specified user
preference (Gabrielsson, Page 13, Lines 24-25). Furthermore, Gabrielsson teach a
process of thinning message size by removing message L component and replacing
with document identifier (Gabrielsson, page. 8, lines 9-20 . In addition Gabrielsson
teaches the thinning process is implemented for accommodate client capability, e.g.,
suitable to client's capabilities e.g., bandwidth, access capability (Gabrielsson, page 8,
lines 3-17). Gabrielsson disclosed _detecting an intended recipient's receiving device_
during a request from the recipient to retrieve the particular message (Gabrielsson –
Page 13 Line 25 thru Page 14 Line 15) and thus formatting attachments accordingly.

Thus, it would have been obvious to one of ordinary skill in the art at the time of
the invention was made to modify Rabe-Hesketh by including, the teaching of using
user preference and thinning message to accommodate client capabilities as taught by
Gabrielsson to enable Rabe-Hesketh's system to provide an object in accordance with
user requirement and expand the predefined criteria in Rabe-Hesketh. In doing would
enable Rabe-Hesketh's system to enhance its ability and flexibility in providing services
to the users that have different levels of resources and capabilities (Gabrielsson -

Abstract, Page 1, Line 20-Page 2, Line 8; Page 3, Lines 15-28; Page 4, Lines 9-32;

Page 5, Lines 8-21; Page 6, Line 14-Page 8, Line 20; Pages 9, Lines 5-16; Page 12,

Lines 9-25; Page 13, Lines 20-Page 14, Line 23).

Regarding claims 2 and 3, Rabe-Hesketh-Gabrielsson discloses, preference is

associated with a particular user (Gabrielsson, Page. 13, Lines 24-25).

Regarding claims 7, 8 and 27, Rabe-Hesketh -Gabrielsson discloses preference

includes specifying that attachments which comprise images be transformed from one

file format to another (Gabrielsson - Page 13, Lines 24-25; Page 7, Line 25-Page 8,

Line 8).

Regarding claim 9 and 49, Rabe-Hesketh -Gabrielsson discloses receiving the

particular message at an SMTP server (Rabe-Hesketh, Page 4, Lines 21-26).

Regarding claim 10-11, Rabe-Hesketh -Gabrielsson discloses removing

attachment could be done at anywhere server including a mail server or at MTA, which

employed SMTP protocol.

Implicitly, Rabe-Hesketh-Gabrielsson has readily taught removing an attachment

at SMTP server or by the SMTP server.

Regarding claims 12-14, 47-48, Rabe-Hesketh -Gabrielsson discloses message

includes a MIME attachment (Babe-Hesketh - Page 3, Lines 24-37).

Regarding claims 15 and 33, Rabe-Hesketh -Gabrielsson discloses link

comprises a Uniform Resource Locator (URL) referencing said attachment that has

been removed (Rabe-Hesketh Page 6, Lines 2-8; Page 12, Lines 18-30).

Regarding claims 16-17, 19-20 and 28, Rabe-Hesketh -Gabrielsson discloses

copy of the particular attachment is automatically formatted when a request is received

to retrieve the particular attachment (Gabrielsson - Page 3, Lines 19-27; Page 7, Line

25-Page 8, Line 20).

Regarding claims 21-22 and 26-, Rabe-Hesketh-Gabrielsson discloses the

invention substantially, as described in claim 1, including a notion of thinning and

filtering, which are clearly applicable for down scaling image size and removing image

detail, e.g,, resolution, fidelity or removing color, which consequently would decrease

fidelity or resolution of the image (Gabrielsson - Page 7, Line 25-Page 8, Line 20).

Regarding claims 23, 30, Rabe-Hesketh-Gabrielsson discloses formatted copies

of objects within the particular attachment are stored in a network repository (Rabe-

Hesketh Fig. 2, storage 27; Gabrielsson - Fig. 1, storage 100, 120).

Regarding claim 24, Rabe-Hesketh-Gabrielsson discloses network repository is accessible by a Web browser for shared access among multiple participants (Rabe-Hesketh Fig4, 48; Fig 5A-5C).

Regarding claims 25, 31 and 32, Rabe-Hesketh-Gabrielsson discloses attachment includes JPEG-formatted digital images (Gabrielsson, Page 7, Lines 3-6).

Regarding claim 50, Rabe-Hesketh discloses attachment-processing module operates as a plug-in module to an e-mail server (Babe-Hesketh - Fig. 2, MTA 2, plug-in 25).

Response to Arguments

Applicant's arguments filed 01/13/2006 have been fully considered but they are not persuasive.

The Applicant presents the following arguments [in italics]:

'in Gabrielsson, the decision to 'thin' an electronic message is based on predefined user preferences...'

The Examiner notes that the claim language indicates dynamically detecting the recipient's receiving device. This is clearly taught by Gabrielsson because Gabrielsson allows users to request and access email from different devices and recognize each device dynamically. It would have been well-known in the art that content negotiation (as described in Internet Standard IETF RFC Document 2616 – Hypertext Transfer Protocol, Section 12 – Content Negotiation and Section 14- Accept , Section 14.43 – User Agent) is performed as part of establishing communications between a server and a client device, wherein said content negotiation establishes the

rendering capabilities of the client device requesting data from the server. The USER-AGENT field is used for automated recognition of user agents for the sake of tailoring responses to avoid particular user agent limitations. Thus, in dynamically detecting a recipient's receiving device, Gabrielsson is also able to determine the maximum rendering capabilities of said receiving device, and is able to reformat the e-mail attachment accordingly.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 20030093565 A1 Berger, Adam L. et al. - converting an attachment in an e-mail for delivery to a device of limited rendering capability

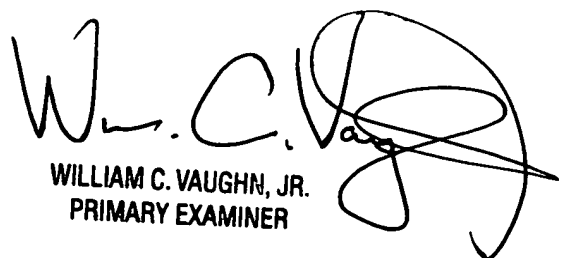US 20020169823 A1 Coulombe, Stephane et al. - transcoding content

US 20020120693 A1 Rudd, Michael L. et al. - E-mail conversion service

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcb

WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER